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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

rinc0001

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10086253

Filed

First Named Inventor

Barbara A. RINCAVAGE

Art Unit

3623

Examiner

Robert D. RINES

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

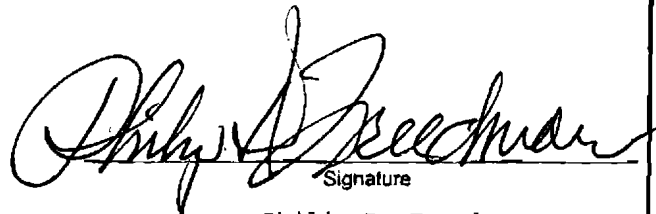
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 24163

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Philip D. Freedman

Typed or printed name

717 490-6245

Telephone number

27JUL2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of

Barbara A. Rincavage

Group Art Unit: 3623

Application No. 10086253

Examiner: RINES, Robert D.

Filed: 01MAR2002

For: SYSTEM AND METHOD FOR FILLING MEDICAL PRESCRIPTIONS

**PRE-BRIEF ARGUMENT**

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of the above-identified application:

**I. BACKGROUND**

The invention relates to a network for a pharmacist to communicate with a physician. This Application was filed March 1, 2002. A September 2, 2009 Board of Appeals decision upheld a final rejection rejecting claims under 35 U.S.C. §103(a) over Denny 20040107117 (“Denny”) and Borsand et al. 20030074225 (“Borsand”) and rejecting claims under 35 U.S.C. §103(a) over Denny, Borsand and Keresman III, et al. (“Keresman”). Applicants filed an October 30, 2009 Amendment after Final with RCE to cancel all claims and substitute the presently pending new claims 21 to 30 to a “prescription fulfillment method” and claims 31 to 40 to a “prescription fulfillment system.”

On December 16, 2009, the Patent Office issued an Office Action and on April 27, 2010, a Final Rejection rejecting claims 21 to 22, 27 to 30, 31 to 32 and 37 to 40 under 35U.S.C. §103(a) over Denny and Borsand and rejecting claims 23 to 26 and 33 to 36 under 35 U.S.C. 103 (a) over Denny, Borsand and Keresman. These rejections are the only issue in this Pre-Brief Review. Applicants file this Pre-Trial Request for Review to

argue that (1) a reference (Denny) applied in the rejections is not prior art to Application and (2) the references do not make out a *prima facie* case of obviousness of the invention.

Current method claims 21 to 30 recite “entering [a] filled and different medication brand or dosage into [a] processing center in fulfillment of [a] prescribed prescription” (the new method recitation) and current system claims 31 to 40 recite a processing center that “accepts filled prescription information through the network from the pharmacist in fulfillment of the prescribed information but that differs in at least one respect from medication brand or dosage of the prescribed prescription information” (the new system recitation).

Applicants argue that:

The new claims claim an aspect of the invention relating to a system and method that admits of a pharmacist’s discretion in filling a prescription. Prior art methods and systems (Denny, Keresman and Borsand [footnote omitted]) allow a pharmacist to enter a “yes” signal for a filled description that confirms filling of a prescription issued by a physician or medical provider. However, there are instances where a pharmacist should properly exercise discretion in filling the brand or dosage of the prescription. For example in instances, a pharmacist may fill a prescription with a generic rather than a prescribed name brand or with a dosage that is equivalent but different from prescribed dosage, e.g. 20 pills at half strength for 10 prescribed pills at full strength). However, prior art “yes” methods and systems do not provide for entering a filled description that is different with respect to brand or dosage.

Page 6 of October 30, 2009 Amendment.

The April 27, 2010 Final Rejection rejected claims 21 to 22, 27 to 30, 31 to 32 and 37 to 40 under 35 U.S.C. 103(a) over Denny and Borsand and rejected claims 23 to 26 and 33 to 36 over Denny, Borsand and Keresman.

## **II. THE DENNY REFERENCE IS NOT PRIOR ART**

The Denny Publication 2004/0107117 application was filed May 29, 2002. Denny is not prior art to Applicants’ Application filed March 1, 2002. See 35U.S.C. §102(e). The rejections based on the Denny reference must be overturned.

### III. THE CITED REFERENCES DO NOT ESTABLISH PRIMA FACIE OBVIOUSNESS

During patent examination the PTO bears an initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The MPEP is in accord: "To establish a *prima facie* case of obviousness,... the prior art reference (or references when combined) must teach or suggest all the claim limitations," MPEP 2143.

To make out a *prima facie* case of obviousness, the PTO must show in the references (by column and line) the teaching that purportedly renders the invention obvious. See *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed.Cir. 1993). If the PTO cannot point to express statements or implied suggestions of the claimed method or system invention in Borsand or Denny (the references applied to the independent claims 21 and 31) then the rejections must be withdrawn. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The references do not teach or suggest the new method recitation and do not teach or suggest the new system recitation. The rejections under 35U.S.C. §103(a) over Denny and Borsand and over Denny, Borsand and Keresman must be overturned.

At page 7, the office action states:

... as is evidenced by Borsand et al., it is well known in the prescription fulfillment art for the pharmacist to record or enter into a database, information regarding the specifics of a filled prescription including cost, drug type, and quantity administered to the patient. Accordingly, Borsand et al. teach a method wherein said filled prescription data includes information for said presented pharmaceutical type and said presented quantity and "wherein the filled prescription is different from the retrieved prescription in respect of at least one or medical brand and dosage..." (Borsand et al.; paragraphs [0005] [0040] [0056] [0064] [0086] [0118] \*see electronic representation of filled prescription).

Applicants have searched Borsand for the text material quoted by the Final Rejection. There is no such text. Applicants have reviewed Borsand paragraphs [0005], [0040], [0056], [0064], [0086] and [0118] for any teaching or suggestion of "entering [a]

filled and different medication brand or dosage into the processing center in fulfillment of [a] prescribed prescription..." (new method recitation). No such teaching or suggestion appears.

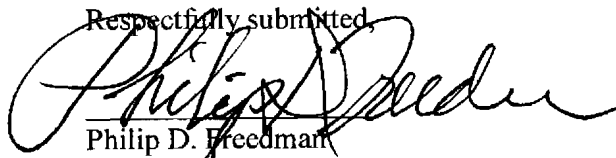
Applicants have reviewed all of the disclosures of Denny, Borsand and Keresman. No teaching or suggestion appears of "entering [a] filled and different medication brand or dosage into [a] processing center in fulfillment of [a] prescribed prescription" (new method recitation). No teaching or suggestion appears of a processing center that "accepts filled prescription information through the network from the pharmacist in fulfillment of the prescribed information but that differs in at least one respect from medication brand or dosage of the prescribed prescription information" (the new system recitation). The references do not make out a *prima facie* case of obviousness,

The rejection of claims 21 to 22, 27 to 30, 31 to 32 and 37 to 40 under 35 U.S.C. 103(a) over Denny and Borsand and the rejection of claims 23 to 26 and 33 to 36 over Denny, Borsand and Keresman under 35 U.S.C. 103(a) must be withdrawn..

#### IV. CONCLUSION

A Decision withdrawing the rejections of claims 21 to 22, 27 to 30, 31 to 32 and 37 to 40 under 35 U.S.C. §103(a) over Denny and Borsand and the rejection of claims 23 to 26 and of claims 33 to 36 under 35 U.S.C. 103 (a) over Denny, Borsand and Keresman is requested.

Respectfully submitted,



Philip D. Freedman  
Reg. No. 24,163  
Philip D. Freedman PC  
PTO Customer Number 25101  
1449 Drake Lane  
Lancaster, Pennsylvania 17601  
717 490-6245  
703 313-0171 (cell)

Lancaster, Pennsylvania

27 JUL, 2010